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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,895	01/16/2004	Guy Eden	SLA1496	8472

7590 02/28/2007
Law Office of Gerald Maliszewski
P.O. Box 270829
San Diego, CA 92198-2829

EXAMINER

SAN JUAN, MARTINJERIKO P

ART UNIT	PAPER NUMBER
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2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/759,895	EDEN ET AL.	
	Examiner	Art Unit	
	Martin Jeriko P. San Juan	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/16/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/16/04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

This is a response to the following case application:

Non-provisional Application No: 10/759895 filed on January 16, 2004.

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- a. It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.
- b. It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.
- c. It does not identify the citizenship of each inventor.
- d. The clause regarding "willful false statements ..." required by 37 CFR 1.68 has been omitted.

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because these are not presentable for public use. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

2. The drawings are objected to because reference transition characters "Fig. 5A" and "Fig. 5B" causes confusion to actual referenced Figures. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should

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include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3-6, 9-10, 17-18, 20-23, 26-27, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiegley (US PN: 6711677 B1).

a. Based on independent claim 1, Wiegley teaches a method for securing network-connected resources [network-connected printer – Col 3, Ln 30], the method comprising: at a first network-connected node, receiving an electronically formatted job [print job – Col 4, Ln 1]; receiving CK [session key -- Col 4, Ln 49], a symmetrical encryption key (K) encrypted using an asymmetrical encryption public key (pubK) [Col 4, Ln 54]; receiving CH, a hash (H) of the job, further encrypted using K [Col 5, Ln 32]; decrypting CK using an asymmetrical encryption private key (privK), corresponding to pubK, to recover k [Col 5, Ln 4]; hashing the job, generating H' [Col 5, Ln 36]; using K to validate CH [Col 5, Ln 36]; in response to validating CH, decrypting an encrypted resource using K [session identifier -- Col 6, Ln 67]; and, using the decrypted resource to process the job [Col 6, Ln 3].

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- b. With regard to dependent claim 3, Wiegley teaches the method of claim 1 wherein using K to validate CH includes: decrypting CH using K, generating H [Col 5, Ln 37]; and, comparing H to H' [Col 5, Ln 39].
- c. With regard to dependent claim 4, Wiegley teaches the method of claim 1 further comprising: prior to receiving the job, CK, and CH, receiving the encrypted resource; and, storing the encrypted resource [Col 4, Ln 21].
- d. With regard to dependent claim 5, Wiegley teaches the method of claim 4 further comprising: installing pubK, privK upon initialization [Col 4, Ln 30].
- e. With regard to dependent claim 6, Wiegley teaches the method of claim 1 wherein receiving an electronically formatted job includes receiving a print job in a format selected from the group including text and image formats [Col 4, Ln 1]. Any print-job coming from other image forming devices [Col 3, Ln 24] will inherently be in a format selected from the group including text and image formats.
- f. With regard to dependent claim 9, Wiegley teaches the method of claim 4 wherein receiving the encrypted resource includes receiving the encrypted resource in a format selected from the group including hypertext transport protocol (http) and file transport protocol (FTP) [Col 1, Ln 21].
- g. With regard to dependent claim 10, Wiegley teaches the method of claim 1 further comprising: at a second network-connected node, generating the job [Col 3, Ln 41]; encrypting K with pubK, generating CK [Col 4, Ln 53]; hashing the job, generating H [Col 5, Ln 31]; encrypting H using K, generating CH [Col 5, Ln 31]; and, sending the job, CK, and CH to the first node for job processing [Col 4, Ln 53] [Col 5, Ln 31].
- h. Independent claim 17 is rejected using the same references as dependent claim 10. Claim 17 limitations are identical to claim 10 except for a network-connected "processing" resource. Wiegley teaches a method for accessing network-connected processing resource [image digital-output device].
- i. Independent claim 18 is rejected using the same references as independent claim 1 and in light of Weigley's description of other possible hardware system components [starting at Col 3, Ln 19]. Claim 18 is merely a system performing the methods of claim 1.
- j. Dependent claims 20-23, and 26-27, are rejected using the same references as dependent claims 3-6 and 9-10 because claims 20-23 and 26-27 are the same system as claim 18 performing the additional methods of claims 3-6 and 9-10.

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- k. Independent claim 34 is rejected using the same references as claim 17. Claim 34 is merely the system performing the methods of claim 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 2 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiegley (US PN: 6711677 B1).

a. With regard to dependent claim 2, Wiegley teaches the method of claim 1 wherein using K to validate CH includes: decrypting CH using K, generating H [Col 5, Ln 37]; and, comparing H to H' [Col 5, Ln 39].

Wiegley does not teach the method of encrypting H' using K, obtaining CH' and matching CH to CH'. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to also use the inverse of Wiegley's cryptographic methods, that is encrypting H' using K, obtaining CH' and matching CH to CH', to achieve an equivalent validation results.

b. Dependent claims 19 is rejected using the same references and rationale as dependent claims 2 because this claim is the same system as claim 18 performing the additional methods of claim 2.

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2. Claims 11-16 and 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiegley [US PN: 6711677 B1], and further in view of Slick et al. [US PN: 7003667 B1].

a. With regard to dependent claims 13, Wiegley does not teach aspects of the plurality of network-connected resources, N_i where $1 \leq i \leq n$ yielding CK_i , CH_i , and $privK_i$. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the identical methods of claim 1 to accommodate the plurality of resources as embodied by Slick et al. [Figure 1].

b. With regard to dependent claims 14, Wiegley teaches all aspects of K_i indicating multi-sessions [Col, 4 Ln 8].

Wiegley does not teach aspects of the plurality of network-connected resources, N_i where $1 \leq i \leq n$ yielding CK_i , CH_i , and $privK_i$. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the identical methods of claim 1 to accommodate the plurality of resources as embodied by Slick et al. [Figure 1].

c. Dependent claim 16 has same limitations as claim 3 with the accommodation of the plurality of network-connected resources, N_i where $1 \leq i \leq n$ yielding CK_i , CH_i , and $privK_i$. Wiegley teaches all limitations of claim 3. Wiegley does not teach aspects of the plurality of network-connected resources, N_i where $1 \leq i \leq n$ yielding CK_i , CH_i , and $privK_i$. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the identical methods of claim 3 to accommodate the plurality of resources as embodied by Slick et al. [Figure 1].

d. Dependent claim 15 has the same limitations as claim 2 with accommodating multiple network-connected resources, N_i where $1 < i < n$ yielding CK_i , CH_i , and $privK_i$.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use an equivalent inverse of the cryptographic validation methods of claim 1 to obtain the methods of claim 2. Also, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the identical methods of claim 2 to accommodate the multiple network-connected resources of claim 16 as embodied by Slick et al. [Figure 1].

e. With regard to dependent claim 11, Wiegley teaches the decryption of an encrypted resource using K , in response to a valid match, includes decrypting the selected resource [Col 6, Ln 67].

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Weigley does not teach receiving a selection command for a particular one of a plurality of encrypted resources in his network scheme. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement receiving a selection command for a particular one of a plurality of network-connected resources, if a plurality of network-connected resources exist as embodied by Slick et al [Figure 1].

f. With regard to dependent claims 12, Wiegley does not teach receiving a selection command for a particular one of a plurality of encrypted resources in his network scheme, and wherein decrypting the selected resource in response to the encrypted resource selection command, includes decrypting Cki to recover one of symmetrical encryption keys k1 through km, where k1 through km correspond to encrypted resources CR1 through CRm.

Since it would have been obvious to one of ordinary skill in the art at the time of the invention to implement receiving a selection command for a particular one of a plurality of network-connected resources, if a plurality of network-connected resources exist as embodied by Slick et al [Figure 1], it would also be obvious that a multiple network-connected resources [printers] would yield multiple Ks [session keys] and CRs [session/printer IDs] corresponding to a particular network-connected resource [printer] in Wiegley's scheme.

g. Dependent claims 28-33 are rejected using the same references as dependent claims 11-16 because claims 28-33 are the same system as claim 18 performing the additional methods of claims 11-16.

3. Claim 7-8 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiegley [US PN: 6711677 B1], and further in view of Konsella et al. [US PN: 6856317 B2].

a. With regard to dependent claims 7-8, Wiegley does not teach the method of claim 4 wherein storing the encrypted resource includes storing an encrypted font resource selected from the group including a logo, personal signature image, and glyph; and, wherein using the decrypted resource to process the job includes printing a print job using the decrypted fonts.

Konsella et al. teaches a method for storing public and secure font data including glyph data [Col 2, Ln 56] in a font file [Col 2, Ln 54] that can now be easily distributed for secured usage. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate secure font data files as part of the encrypted resources in Wiegley's secured printing method.

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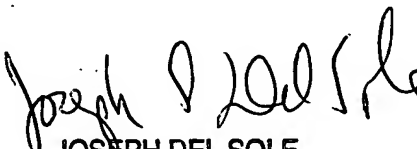
- b. Dependent claims 24-25 are rejected using the same references and rationale as dependent claims 7-8 because these claims are the same system as claim 18 performing the additional methods of claims 7-8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Jeriko P. San Juan whose telephone number is 571-272-7875. The examiner can normally be reached on M-F 7:30a - 5:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on 571-272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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SUPERVISORY PATENT EXAMINER
2/26/07